

REMARKS

Claims 1-13 are presented. Amended claim 1 concerns a ground, powdered toner, as provided for in the specification at page 16 and page 56, as examples. Amended claims 6-9 address the objection. Non-elected claims 10-13 are retained but may be canceled by an Examiner's Amendment to place this case in for allowance. Or, if the Examiner wishes, the toner definitions in claims 10-13 can be conformed to the elected claims and rejoined.

The amended specification corrects the language to conventional English.

The amendments avoid new matter.

Applicant calls attention to the Information Disclosure Statements filed October 19, 2007 and December 3, 2007, respectively. It is presently understood that both Information Disclosure Statements were timely, properly filed. A petition fee is not seen as necessary.

Claims 1-5 define novel inventions one U.S. Patent No. 5294,513 to Mitchell et al.

Claim 1 refers to a thin – film coated toner that is a ground, powder toner with a softening temperature ranging from 40 to 150°C whose surface is coated substantively continuously with the thin film comprising a thermosetting resin.

A ground powder toner has a lower sphericity, lower roundness or extreme surface unevenness compared with a polymerized toner (see [0143] of the US publication of the present application). It should be appreciated that it is difficult, indeed a challenge, to coat uniformly a thin-film on the surface of the ground toner.

Yet, the present invention provides a toner wherein a thin-film is uniformly coated on the surface of ground toner.

The thin-film coated toner of the present invention exhibits a good anti-blocking property and it is possible to achieve sufficient resolution of formed images by using the thin-film coated toner.

In addition, because the thin-film coated toner inherits the shape of the ground, powder toner particles, the thin-film coated toner has lower sphericity and an uneven surface.

With this toner, it is easy to detach residual toner from a photoconductive drum in a cleaning step in an electro photographic process.

The surface the ground toner is hydrophobic, which is essential from its producing methods. Upon encapsulating a particle, depending on whether the particle is hydrophilic or hydrophobic, situations of dispersion and film-formation are quite different, and as one does not forecast the other in terms of performance.

The surface of a polymerized toner is hydrophilic.

Therefore, from a practical point of view, it is completely impossible to know or predict based on the Mitchell reference whether it is possible or not possible to encapsulate a hydrophobic particle (ground toner).

The Mitchell reference, does not apparently describe toner particles that are produced by grinding toner particles to pulverulent or powdered form. The Mitchell reference therefore does not appear to describe the claimed inventions.


The Mitchell reference is additionally silent as to the softening temperature and the fusing temperature as candidly acknowledged in the Office Action, page 4.

The Mitchell reference does not equate toner particles obtained by polymerization or deposition with ground, powdered particles. This is quite evident from Mitchell's Example 1 at Column 7. Therefore, Applicant courteously submits the evidence from

Mitchell itself defeats inherency, and Mitchell is not certainly evidence to support the reasoning bridging page 4 to pages 5 in the Office Action.¹

Accordingly, Applicant courteously solicits the Examiner's favorable reconsideration and followed by a Notice of Allowance.

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¹ The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *Roscco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 1380–81 (Fed. Cir. 2002); *MEHL/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1362, 1365 (Fed. Cir. 1999). Anticipation by inherency “is appropriate only when the reference discloses prior art that must *necessarily* include the unstated limitation.” *Transclean Corp. v. Bridgewood Services, Inc.*, 62 U.S.P.Q.2d 1865, 1871 (Fed. Cir. 2002) (emphasis in original). “Inherency . . . may not be established by probabilities or possibilities. There mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, , 1951, (quoting *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269, 20 U.S.P.Q.2d 1746, 1749).